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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,310

12/12/2003

Tomohiro Shinoda

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EXAMINER

LEUNG, JENNIFER

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/733,310	<b>Applicant(s)</b> SHINODA, TOMOHIRO	
	<b>Examiner</b> Jennifer Leung	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**This Office Action is in response to the Remarks filed on 2/5/2007. Claims 1-3 and 5-8 are pending.**

#### ***Specification***

1. The disclosure is objected to because of the following informalities:

Page 11, line 7: "display monitor 26" should be -- display monitor 14 --.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Appropriate correction is required.

#### ***Claim Objections***

3. Claims 1, 7, and 8 are objected to because of the following informalities:

Claim 1, line 8; Claim 7, line 11; Claim 8, line 7: "wherein" should be inserted before "the status".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 2, 3, 5, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 6,468,162).

Re claim 1: Nakamura discloses a gaming machine comprising data reading means for reading character data from at least one inserted trading card (col. 6, lines 35-39) under control of a CPU (20, 25, Fig. 2); and payout means for paying out at least one reward trading card (72) (see Fig. 3A; col. 13, lines 18-19) under control of the CPU (20, 23, 26, Fig. 2), wherein the at least one reward trading card stores updated character data on a basis of both a status of a game and the character data read by the data reading means (col. 4, lines 5-8; col. 9, lines 54-56; col. 10, lines 23-27), the status is the prescribed conditions that are satisfied in the game (col. 3, lines 9-12; col. 11, lines 35-53; col. 16, lines 29-32).

Re claim 2: Nakamura further discloses a payout means, which pays out the at least one inserted trading card as the at least one reward trading card (68, 70) (see Fig 3A; col. 15, lines 2-4: if the character information of the inserted memory card is updated, then the same card is used as the reward trading card).

Re claim 3: Nakamura further discloses the payout means that includes writing means for writing the updated character data in the at least one reward trading card (col. 6, lines 25-28).

Re claim 5: Nakamura further discloses the character data, which includes capability and attribute values (col. 6, lines 17-25).

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Re claim 6: Nakamura further discloses the payout means (col. 13, lines 18-19) that includes printing means for printing an image on a surface of the at least one reward trading card (col.13, lines 11-13).

Re claim 8: Nakamura discloses a method for controlling a gaming machine including a card reader (col. 6, lines 35-39) and a card writer (col. 6, lines 25-28), comprising: reading character data from at least one inserted trading card (col. 6, lines 35-37); advancing a game based on the character data (col. 6, lines 44-51; col. 9, lines 32-33); and writing updated character data to at least one reward trading card, the updated character data being on a basis of both a status of the game and the character data read by the card reader (col. 4, lines 5-8; col. 9, lines 54-56; col. 10, lines 23-27), the status is the prescribed conditions that are satisfied in the game (col. 3, lines 9-12; col. 11, lines 35-53; col. 16, lines 29-32).

6. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Muroi (US 2002/0052238).

Re claim 7: Muroi discloses a gaming machine comprising a card reader which reads character data from at least one inserted trading card (claim 1, lines 13-17); a card writer which writes updated character data on at least one reward trading card (claim 1, lines 13-15; paragraph 0039, lines 3-6); and a controller (11: CPU, which functions as a controller) which executes a predetermined computer program (pg. 5, right col., claim 8, lines 1-4), the controller (11) being

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connected to the card reader and the card writer (Fig. 1: the CPU is connected to the reader/writer through the data/address bus (1K) and the transmission/reception interface), wherein the controller causes the card reader to read the character data from the at least one inserted trading card (claim 8, lines 1-7), causes a game to advance on a basis of the character data read by the card reader (claim 8, lines 11-14), and causes the card writer to write the updated character data on a basis of both a status of the game and the character data read by the card reader (claim 8, lines 16-18; claim 4, lines 5-9), the status is the prescribed conditions that are satisfied in the game (last sentence of para. 0006; para. 0032).

Re claim 8: Muroi discloses a method for controlling a gaming machine including a card reader (claim 1, lines 13-17) and a card writer (claim 1, lines 13-15), comprising: reading character data from at least one inserted trading card (claim 8, lines 5-7); advancing a game based on the character data (claim 8, lines 11-14); and writing updated character data to at least one reward trading card, the updated character data being on a basis of both a status of the game and the character data read by the card reader (claim 8, lines 16-18; claim 4, lines 5-9), the status is the prescribed conditions that are satisfied in the game (last sentence of para. 0006; para. 0032).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Buckley (US 5,036,472). The teachings of Nakamura have been discussed above.

However, Nakamura fails to disclose or fairly suggest the selecting means for selecting the at least one reward trading card among a plurality of trading cards stocked in the gaming machine. Buckley teaches a selecting means for selecting a card form among a plurality of forms stocked in a machine (Fig. 4; col. 6, lines 21-22; col. 1, lines 46-54).

Therefore, in view of Buckley, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a selecting means for selecting a card to Nakamura's gaming machine in order to allow selection of a particular reward trading card from a stack of cards with character data stored in advance instead of having to update character data and reprint an image on the inserted trading card.

***Response to Arguments***

9. Applicant's arguments, page 7 of Remarks filed 2/5/2007, with respect to the drawing and claim objections have been fully considered and are persuasive. The objections of the drawing and claim have been withdrawn due to amendment by the applicant.

10. Applicant's arguments, page 7 of Remarks filed 2/5/2007, with respect to the objection of the abstract and pages 9, 12, 15, 16, and 19 of the specification have been fully considered and are persuasive. The objection to the abstract and these pages of the specification has been withdrawn due to amendment by the applicant. However, the objection to page 11 of the specification is maintained. The applicant modified the incorrect reference number.

11. Applicant's arguments, page 7 of Remarks filed 2/5/2007, with respect to Claim Rejections - 35 USC § 112 have been fully considered and are persuasive. The 35 USC § 112, first paragraph, rejection is now moot due to cancellation by applicant. The 35 USC § 112, second paragraph, rejection has been withdrawn due to amendment by applicant.

12. Applicant's arguments, pages 7-8 of Remarks filed 2/5/2007, with respect to the Nakamura reference have been fully considered but they are not persuasive. Applicant states that in the claimed invention, the character data is renewed under a specific status. And then proceeds to state that that this limitation is not found in the Nakamura reference. However, this limitation is found in Nakamura. Nakamura discloses the character data being updated depending on the result of the game (col. 3, lines 9-12; col. 11, lines 35-53; col.



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16, lines 29-32). Status of a game can be shown through game results. Likewise, status of a character can be shown through HP or MP.

13. Applicant's arguments, pages 8 of Remarks filed 2/5/2007, with respect to the Muroi reference have been fully considered but they are not persuasive.

First, the applicant makes the same argument as above: that the claim limitation, the character data is renewed under a specific status, is not found in the Muroi reference. However, this limitation *is* found in Muroi. Muroi discloses that the character data can be rewritten "depending on the progressing state of the game" (last sentence of para. 0006; para. 0032). The specification of the current application states on page 16, lines 11-12: "for example, a condition of the main character having arrived at a prescribed place in the virtual world". The examiner interprets the phrase "conditions are satisfied" to mean that the character has progressed to a certain point in the game. Because the applicant uses this phrase to define "status", the examiner interprets the term "status" to also mean progression of the game, which Muroi explicitly discloses in the last sentence of paragraph 0006.

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "mix a plurality of characters") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kimura discloses a card printer in a card information management system. Ishihara discloses a game system using game cards and game machine.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

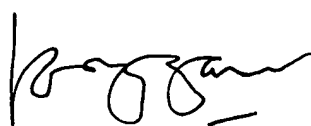
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jennifer Leung  
March 30, 2007

 4/12/07  
**KIM NGUYEN**  
**PRIMARY EXAMINER**